UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,825	05/22/2001	Satoru Ueda	7217/64562	8871

7590   07/13/2005

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EXAMINER
YIGDALL, MICHAEL J

ART UNIT	PAPER NUMBER
2192	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/862,825	UEDA, SATORU
	Examiner	Art Unit	
	Michael J. Yigdall	2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 April 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-5,7 and 10* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-5,7 and 10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on March 18, 2005 has been entered. Claims 1, 3-

5, 7 and 10 are pending.

Response to Arguments

2.   Applicant's arguments with respect to the claims have been considered but are moot in

view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   Claims 1, 3-5, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

International Pub. No. WO 97/14085 to Reeder (art of record, "Reeder") in view of U.S. Pat. No.

5,375,240 to Grundy (art of record, "Grundy") in view of U.S. Pat. No. 6,081,785 to Oshima et

al. (art of record, "Oshima").

With respect to claim 1 (currently amended), Reeder discloses a software program

providing system for providing and managing access to a software program (see, for example,

FIG. 1 and page 3, lines 11-15), comprising:

(a) a storage medium for storing said software program and an individual identification

code for identifying said storage medium (see, for example, store 150 in FIG. 1, and page 5, lines

1-7, which shows a store or storage medium for storing a software program and an identification

code used to identify the program in the storage medium);

(b) a user terminal for installing said storage medium therein and for accessing said

software program stored in said storage medium (see, for example, apparatus 100 in FIG. 1, and

page 3, lines 11-15 and line 32 to page 4, line 6, which shows a personal computer or user

terminal having a storage medium installed therein for storing and accessing software programs;

also see, for example, page 5, lines 10-14, which shows obtaining the software program and

storing it in the storage medium);

(c) database management means for storing a database including individual information

of a user, information regarding a range of access limitations to said software program, and

information regarding a condition of access to said software program, wherein said database is

searched using said individual identification code as a search key (see, for example, code data

230 and bill log 240 in FIG. 1, and page 6, line 37 to page 7, line 5, which shows a data store or

database having individual user information regarding software usage rights, i.e. access

limitations and conditions of access, which is searched based on an identification code), wherein

said information regarding said range of access limitations includes a plurality of supplemental

pay functions and said information regarding said condition of access includes purchased counts

and used counts (see, for example, page 10, lines 17-27, which shows a plurality of supplemental

pay features or functions; also see, for example, page 11, lines 8-19, which shows a condition of

access for the feature or function based on a message number, and page 10, lines 31-34, which

shows that the message number is incremented when a feature or function is purchased and thus

represents a purchased count; also see, for example, page 11, line 31 to page 12, line 14, which

shows recording each use of the feature or function, i.e. as a used count), and

said database management means further comprises fee charging means for charging a

fee for adding purchased counts only to access a selected one of said plurality of supplemental

pay functions (see, for example, page 9, lines 25-27, which shows fee charging means for

charging a fee to access the supplemental pay functions; also see, for example, page 13, lines 7-

15, which shows that access to the functions may be prepaid).

Although Reeder discloses charging a fee for supplemental pay functions (see, for

example, page 9, lines 25-27), Reeder does not expressly disclose the limitation wherein said

software program is accessed for free unless access to one of said plurality of pay functions is

requested.

However, Grundy discloses a system for distributing and managing access to a software

program that is accessed for free unless access to certain functions is requested, so that the user

may freely evaluate and legally distribute copies of the software program without paying a fee

(see, for example, column 4, lines 28-42 and 51-59).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the system of Reeder such that the software program is accessed for free

unless access to one of said plurality of pay functions is requested, as taught by Grundy, so as to

allow the user to evaluate and legally distribute the software program without paying a fee.

Reeder also discloses:

(d) information communication means for connecting said database management means

with said user terminal (see, for example, communications link 10 and network 20 in FIG. 1, and

page 3, lines 21-31), wherein

said software program providing system authorizes said user terminal to access said

software program stored in said storage medium based on said information regarding said range

of access limitations (see, for example, page 7, lines 30-37), said information regarding said

condition of access to said software program, and said information searched using said individual

identification code as said search key (see, for example, page 6, line 37 to page 7, line 5), said

database management means reading said individual identification code from said storage

medium installed in said user terminal through said information communication means (see, for

example, page 10, lines 6-17, which shows reading a identification code from a storage medium,

and page 11, lines 15-29, which then shows authorizing the use of a software program based on

access limitations and conditions).

Reeder does not expressly disclose limitation wherein said storage medium is a

removable storage medium.

However, Oshima discloses a system for providing and managing access to a software

program stored with an identification code on a removable, optical storage medium, wherein the

software is installed on a user terminal from the removable storage medium, for the purpose of

preventing illegal copying of the software (see, for example, column 10, lines 15-54; also see, for example, FIG. 11, which shows a personal computer or user terminal and an optical disk drive).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to provide the software program on a removable storage medium to be installed in the user terminal, as taught by Oshima. The modification would have been obvious because one of ordinary skill in the art would have been motivated to enhance the level of protection against illegal copying or installation of the software.

With respect to claim 3 (previously presented), Reeder also discloses the limitation wherein said information communication means further comprises ciphering means for ciphering communication between said database and said user terminal (see, for example, page 7, lines 5-9, which shows an encryption or ciphering process).

With respect to claim 4 (original), although Reeder discloses the use of encryption to provide additional security (see, for example, page 5, line 33 to page 6, line 1), Reeder does not expressly disclose the limitation wherein said storage means further comprises a DVD-ROM and said individual identification code includes a BCA code recorded through a laser beam during a fabrication process of said individual identification code.

However, Oshima further discloses the use of the BCA to store an identification code and a cryptographic key (see, for example, column 1, lines 36-50) on a DVD (see, for example, column 3, lines 63-67), so that a fee may be charged for the use of the disk (see, for example, column 4, lines 60-64). Oshima further discloses that the BCA code is recorded with a laser during fabrication and can be used for security (see, for example, column 3, lines 11-15).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the system of Reeder to use a DVD-ROM storage medium with a BCA

identification code, as taught by Oshima. The modification would have been obvious because

one of ordinary skill in the art would have been motivated to improve security by transcribing the

storage medium with an individual identification code.

With respect to claim 5 (currently amended), Reeder discloses a software program

providing method for providing and managing access to a software program (see, for example,

FIG. 1 and page 3, lines 11-15), comprising the following steps of:

(a) storing said software program in a storage medium along with an individual

identification code for identifying said storage medium (see, for example, store 150 in FIG. 1,

and page 5, lines 1-7, which shows a store or storage medium for storing a software program and

an identification code used to identify the program in the storage medium);

(b) storing into a database, information regarding individual information of a user,

information regarding a range of access limitations to said software program, and information

regarding a condition of access to said software program, wherein said database is searched

using said individual identification code as a search key (see, for example, code data 230 and bill

log 240 in FIG. 1, and page 6, line 37 to page 7, line 5, which shows a data store or database

having individual user information regarding software usage rights, i.e. access limitations and

conditions of access, which is searched based on an identification code), and said information

regarding said range of access limitations includes a plurality of supplemental pay functions and

said information regarding said condition of access includes purchased counts and used counts

(see, for example, page 10, lines 17-27, which shows a plurality of supplemental pay features or

functions; also see, for example, page 11, lines 8-19, which shows a condition of access for the feature or function based on a message number, and page 10, lines 31-34, which shows that the message number is incremented when a feature or function is purchased and thus represents a purchased count; also see, for example, page 11, line 31 to page 12, line 14, which shows recording each use of the feature or function, i.e. as a used count);

(c) charging a fee for adding purchased counts to access a selected one of said plurality of supplemental pay functions (see, for example, page 9, lines 25-27, which shows fee charging means for charging a fee to access the supplemental pay functions; also see, for example, page 13, lines 7-15, which shows that access to the functions may be prepaid).

Although Reeder discloses charging a fee for supplemental pay functions (see, for example, page 9, lines 25-27), Reeder does not expressly disclose the limitation wherein said software program is accessed for free unless access to one of said plurality of pay functions is requested.

However, Grundy discloses a system for distributing and managing access to a software program that is accessed for free unless access to certain functions is requested, so that the user may freely evaluate and legally distribute copies of the software program without paying a fee (see, for example, column 4, lines 28-42 and 51-59).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder such that the software program is accessed for free unless access to one of said plurality of pay functions is requested, as taught by Grundy, so as to allow the user to evaluate and legally distribute the software program without paying a fee.

Reeder also discloses:

(d) communicating between a user terminal having said storage medium installed therein

and a database management means managing said database (see, for example, communications

link 10 and network 20 in FIG. 1, and page 3, lines 21-31),

wherein said communicating is done when said user accesses said software program

stored in said storage medium installed in said user terminal (see, for example, page 5, lines 18-

25, which shows initiating a transmission when the user accesses the software program); and

(d) authorizing said user terminal to access said software program based on said

information regarding said range of access limitations (see, for example, page 7, lines 30-37),

said information regarding said access condition to said software program, and said information

searched from said database based on said individual identification code (see, for example, page

6, line 37 to page 7, line 5), wherein said individual identification code is read out from said

storage medium installed in said user terminal (see, for example, page 10, lines 6-17, which

shows reading a identification code from a storage medium, and page 11, lines 15-29, which then

shows authorizing the use of a software program based on access limitations and conditions).

Reeder does not expressly disclose limitation wherein said storage medium is a

removable storage medium.

However, Oshima discloses a system for providing and managing access to a software

program stored with an identification code on a removable, optical storage medium, wherein the

software is installed on a user terminal from the removable storage medium, for the purpose of

preventing illegal copying of the software (see, for example, column 10, lines 15-54; also see, for

example, FIG. 11, which shows a personal computer or user terminal and an optical disk drive).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to provide the software program on a removable storage medium to be installed in the user terminal, as taught by Oshima. The modification would have been obvious because one of ordinary skill in the art would have been motivated to enhance the level of protection against illegal copying or installation of the software.

With respect to claim 7 (original), Reeder also discloses the limitation wherein said communicating step further comprises the step of ciphering communication between said user terminal and said database management means (see, for example, page 7, lines 5-9, which shows an encryption or ciphering process).

With respect to claim 10 (currently amended), the claim recites a software program providing system that corresponds to the software program providing system of claim 1 (see the rejection of claim 1 above).

Conclusion

5.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (571) 272-3707. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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MY

Michael J. Yigdall
Examiner
Art Unit 2192

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TUAN DAM
SUPERVISORY PATENT EXAMINER